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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92054617
Party	Defendant Y.Z.Y., INC.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark Registration No. 3,504,398  
for the mark BIO CLAIRE registered September 23, 2008.

NOUVELLE PARFUMERIE GANDOUR,

Petitioner,

v.

Cancellation No. 92054617

Y.Z.Y., INC.

Respondent.

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**RESPONDENT Y.Z.Y., INC.’S REPLY TO PETITIONER’S OPPOSITION TO MOTION  
TO DISMISS**

COMES NOW, the Respondent, Y.Z.Y., INC. (“YZY”), who respectfully replies to Petitioner’s NOUVELLE PARFUMERIE GANDOUR (“GANDOUR”) opposition to YZY’s motion to dismiss this proceeding before the Trademark Trial and Appeal Board (“Board”). The opposing memorandum fails to address GANDOUR’s lack of standing due to the deficiency of its pleading. As a result, the motion, respectfully, should be granted. As grounds therefore, YZY submits the following:

1. GANDOUR does not dispute whatsoever the Petition’s lack of any allegation that it used the BIO CLAIRE (“the Mark”) on any goods in the United States **prior to** YZY’s use of it on the subject goods in the United States.<sup>1</sup>

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<sup>1</sup>In *Kelly Services Inc. v. Greene’s Temporaries Inc.*, 25 USPQ 2d 1460 (TTAB 1992), cited by GANDOUR in its opposition, the petitioner alleged **prior use** of the subject mark in interstate commerce of the United States “from a point in time well before respondent’s first use of its registered clover leaf mark....” *Id.* at 1461. *Accord Raintree Publishers, Inc. v. Brewer*, 218 USPQ 272, 273 (TTAB 1983)(allegation of “prior and continuous use of the mark”).

2. The cases cited by GANDOUR misquote the law contained therein. In this regard, GANDOUR argues that its pleading sufficiently establishes ownership of the Mark due to its relationship with YZY. However, the cases cited by GANDOUR are directed to relationships of an exclusive nature. *See Jean D'Albret v. Henkel-Khasana G.m.b.H.*, 185 USPQ 317 (TTAB 1975); *Barker v. Steel Nurse of America, Inc.*, 176 USPQ 447 (TTAB 1972). Here, the Petition does not allege that the parties had an exclusive relationship relative to the goods sold under the Mark. Regardless, even if the Petition were amended to recite exclusivity, GANDOUR does not allege, as argued above, prior use. *See Jean D'Albret* at 320 (“All that need be established...is that [plaintiff] has made use of the mark **prior to** the use of the same or a similar mark by the party defendant....”).
3. Furthermore, not only does the Petition not allege that GANDOUR used the Mark in commerce of the United States prior to YZY use of its Mark, it also does not allege that GANDOUR is contemporaneously using the Mark here. *See Jean D'Albret* at 320 (standing not only requires an allegation of prior use, but it also must allege “that the contemporaneous use of the marks on or in connection with the respective goods of the parties is reasonably likely to cause confusion in trade.”). To the contrary, the Petition establishes that since 2011, its goods under the Mark have not been sold in commerce of the United States. *See* Pet. ¶¶ 4, 5.
4. GANDOUR alleges no greater right to assert its claim than an ordinary member of the general public. Based upon the allegations contained in the Petition, GANDOUR is merely an intermeddler. *See Lipton Indus., Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 1028-29, 213 USPQ 185 (C.C.P.A. 1982).

WHEREFORE, YZY respectfully moves the Board for an order granting the motion. GANDOUR has not, and cannot, allege with any factual accuracy use of the Mark in commerce of the United States prior to YZY's use, or that the relationship between the parties was exclusive. Accordingly, YZY seeks an order from this Board dismissing the Petition with prejudice for failure to state a claim upon which relief may be granted.

Respectfully submitted,

/s/Richard S. Ross, Esq.  
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#### **CERTIFICATE OF SERVICE**

I HEREBY CERTIFY that a true and correct copy of the foregoing has been served by United States Postal Service first class regular mail, and addressed to counsel for the Petitioner:

Scott R. Austin, Esq.  
GORDON & REES LLP  
200 S. Biscayne Bld., Suite 4300  
Miami, Florida 33131

this 16<sup>th</sup> day of February, 2012.

/s/Richard S. Ross, Esq.  
Richard S. Ross, Esq.